

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN J. NESTOR JR., TERESA H. HO,
DEBORAH A. EPPSTEIN, PHILIP L. FELGNER, BARBARA P. BARNA
and SHARAD D. DEODHAR

Appeal No. 94-3208
Application 07/743,613¹

ON BRIEF

Before WINTERS and WILLIAM F. SMITH, Administrative Patent Judges, and McKelvey, Senior Administrative Patent Judge.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 1 through 14 and 20, which are all of the claims remaining in the application.

¹ Application for patent filed August 9, 1991.

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Claim 1, which is illustrative of the subject matter on appeal, reads as follows:

1. A polypeptide having the amino acid sequence A-(SEQ ID NO: 1)-B, A-Ile-Tyr-Leu-Gly-Gly-Pro-Phe-Ser-Pro-Asn-Val-Leu-B, wherein A is H or an acyl group and B is OH or NR₂, each R independently selected from H, C₁-C₆ alkyl, C₁-C₆ haloalkyl, and C₁-C₆ aralkyl.

The prior art references relied on by the examiner are:

Barna et al. (Barna), "Macrophage Activation by a Synthetic Peptide of Human C-Reactive Protein (CRP) (Meeting Abstract)," 46 Federal Proceeding no. 3, 762 (1987).

Deodhar et al. (Deodhar), "Enhanced Anti-Tumor Effect by Combination Therapy with Human C-Reactive Protein (CRP) and IL2 in C57 Mice Bearing the Fibrosarcoma T241," 3 FASEB J. (Meeting Abstract), A831 (1989).

The issue presented for review is whether the examiner erred in rejecting claims 1 through 14 and 20 under 35 U.S.C. § 102(b) as described by Barna or Deodhar.

OPINION

The true test of any prior art relied on to show that a chemical compound is old, is whether the prior art places the disclosed compound in the possession of the public. In re Brown, 329 F.2d 1006, 1011, 141 USPQ 245, 249 (CCPA 1964). Adhering to that test, and elaborating on the relevant principle of law, the court in In re Hoeksema, 399 F.2d 269, 273-74, 158 USPQ 596, 600-01 (CCPA 1968) stated that:

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In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention "not novel" or "anticipated" within section 102 the stated test is whether a reference contains an "enabling disclosure," in the present context, a process by which the claimed compound could be made. [Citation omitted.]

and

[I]t is our view that if the prior art of record fails to disclose or render obvious a method for making a claimed compound, at the time the invention was made, it may not be legally concluded that the compound itself is in the possession of the public. [Footnote omitted.]

Here, the examiner relies on appellants' acknowledgment that "[t]he peptide identified as #83277 [in Barna and Deodhar] is in fact the peptide of this invention." See the amendment after Final Rejection filed July 2, 1993 (Paper No. 10), page 2. On this record, however, the examiner has not established that Barna or Deodhar discloses or renders obvious a method for making the claimed polypeptide. The examiner has not established that the cited references are enabling, i.e., sufficient to place peptide #83277 in the possession of the public. See Akzo N.V. v. Int'l Trade Comm'n, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986); In re Hoeksema, 399 F.2d at 273-74, 158 USPQ at 600-01; In re Brown, 329 F.2d at 1011, 141 USPQ at 249. For this reason, we reverse the rejections under 35 U.S.C. § 102(b). Cf. In re Donohue, 632 F.2d 123, 126, 207 USPQ 196, 199 (CCPA 1980) (PTO's

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reliance on Lincoln and Wagner, showing that a method of making Nomura's compound was in possession of the public, was proper).

The examiner's decision, rejecting claims 1 through 14 and 20 under 35 U.S.C. § 102(b) as described by Barna or Deodhar, is reversed.

REVERSED

SHERMAN D. WINTERS)	
Administrative Patent Judge)	
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WILLIAM F. SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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)	
FRED E. McKELVEY)	
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